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Atty. Dkt. No. ROC920010084US1
MPS Ref. No.: IBMX10084

REMARKS

This is intended as a full and complete response to the Office Action dated December 2, 2004, having a shortened statutory period for response set to expire on March 2, 2005. Please reconsider the claims pending in the application for reasons discussed below.

In the specification, the Title and Abstract have been amended. The Title and Abstract have been amended to clarify the nature of the invention.

Claims 1-28 are pending in the application. Claims 8 and 11-12 remain pending following entry of this response. Claims 8 and 11-12 have been amended. Claims 1-7, 9-10 and 13-28 have been cancelled. New claims 29-45 have been added to recite aspects of the invention. Applicants submit that the amendments and new claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 1-3, 5, 10, 12, 15-17, 19, 24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by *Cai et al.* (U.S. 6,246,757, hereinafter *Cai*). Claims 1-3, 5, 10, 15-17, 19, 24 and 26 have been cancelled. Claim 12 has been amended to be dependent from claim 11.

Claim Rejections - 35 U.S.C. § 103

Claims 4 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cai* in view of *Thomas* (U.S. 6,038,292). Claims 4 and 18 have been cancelled.

Claims 6-9, 14, 20-23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cai* in view of *Bayless et al.* (U.S. 5,754,636, hereinafter *Bayless*). Claims 6-7, 9, 14, 20-23, and 28 have been cancelled. Claim 8 has been amended to incorporate the rejected claims from which it depends. With respect to amended claim 8, Applicants respectfully traverse the rejection.

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. See MPEP § 2141.01(a). A reference is considered analogous prior art if the reference is either in the field of Applicants' endeavor or, if the reference is reasonably

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pertinent to the particular problem with which the inventor was concerned. *Id.* A reference is pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his problem. See *id.*, citing *Wang Laboratories v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993). Furthermore, when determining whether a reference is analogous, the Examiner cannot look at isolated teachings of the prior art without considering the over-all context within which those teachings are presented. *In re Pagliaro*, 657 F.2d 1219, 1225 (Cust & Pat.App., 1981). Thus, the Examiner must consider each reference as a whole and determine if the reference as a whole is concerned with problems associated with the pending application. *Id.*

With respect to the present application, *Bayless* is not analogous prior art because *Bayless* is not directed to a calling card system. See, e.g. *Abstract*. *Bayless* is directed to a computer system which allows telephone numbers in a directory to be accessed by a user. See *Bayless* at Col. 42, Line 44 – Col. 43, Line 6. The sole mention by *Bayless* of calling cards is an aside wherein *Bayless* mentions that a calling card number may be stored in the directory. See *Bayless* at Col. 20, Lines 25-38. A calling card number is not required in order to access the directory in *Bayless*. See *Bayless* at Col. 42, Line 44 – Col. 43, Line 6. Thus, because *Bayless* is not directed to calling cards or calling card systems, *Bayless* is not analogous prior art. Accordingly, *Bayless* cannot be relied on as a reference under 35 U.S.C. § 103.

Even if *Bayless* were analogous prior art, Applicants respectfully submit that the Examiner has not made a *prima facie* case of obviousness because there is no suggestion or motivation to combine *Bayless* and *Cai*. The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined)

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must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first criteria. Specifically, Applicants submit that there is no suggestion or motivation to combine *Bayless* and *Cai* because combining the references as suggested by the Examiner renders at least *Cai* unsatisfactory for its intended purpose, in contradiction to MPEP § 2143.01.

Examiner states that it would have been obvious for any one of ordinary skill in the art to modify the database as taught by *Cai* to include a directory name look up as taught by *Bayless* for the benefit of allowing the user to speed dial by name. See Office Action of Dec. 12, 2004, Pg. 12. While *Bayless* mentions that names in a directory may be searched (See *Bayless* at Col. 42, Line 44 – Col. 43, Line 6), *Cai* does not associate names with numbers in the speed dialing list (See *Cai*, Table 1). Indeed, the purpose of *Cai* is to allow a calling card customer to quickly dial numbers using an abbreviated code. See *Cai* at Col. 2, Lines 16-25. Thus, associating a name with the stored numbers in *Cai* and allowing searches by name would be an unnecessary and inexpedient way to fulfill the purposes of *Cai*. See *id.* Accordingly, since there is no suggestion or motivation to combine the name searching function of *Bayless* with the dialing list of *Cai*, a *prima facie* case of obviousness has not been established.

Therefore, Applicants submit that claim 8 is patentable over *Cai* in view of *Bayless*. Withdrawal of the rejection is respectfully requested.

Claims 11, 13, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Cai* in view of *Haimi-Cohen* (U.S. 5,983,093). Claims 13, 25, and 27 have been cancelled. Claim 11 has been amended to incorporate the rejected claims from which it depends. With respect to amended claim 11, Applicants respectfully traverse the rejection.

A prior art reference used in a 35 U.S.C. § 103 rejection must be considered in its entirety, including portions that teach away from the claimed invention. See MPEP § 2141.02. The pending claims describe processing a telephone calling card identification number received from the telecommunications device, enabling at least one user-defined calling card function using the identification number, and executing the at least

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one user-defined calling card function, wherein executing the at least one user-defined calling card function comprises redialing one of a plurality of previously dialed numbers stored in a dialed numbers data structure.

Haimi-Cohen is directed to a system wherein a phone number is redialed without having the user enter an identification number. See *Haimi-Cohen*, Abstract. The user of the system must enter an identification number the first time a number is called, but the next time the number is called, no identification number need be entered. See *Haimi-Cohen* at Col. 2, Lines 58-63. The purpose of the system in *Haimi-Cohen* is to prevent thieves from stealing a phone and dialing phone numbers which have not been dialed from the phone before. See *Haimi-Cohen* at Col. 2, Lines 22-26 and Col. 2, Lines 36-40. However, if a phone number has been dialed before, the identification number need not be entered again. See *Haimi-Cohen* at Col. 2, Lines 58-63. Accordingly, the system in *Haimi-Cohen* is designed to redial numbers without the user having to reenter the identification number. See *Haimi-Cohen* at Col. 2, Lines 10-19. In the pending claims, the telephone calling card function (redialing one of a plurality of previously dialed numbers) is enabled using the telephone calling card identification number. *Haimi-Cohen* explicitly states that entering such an identification number is annoying, and precisely for this reason is specifically directed to the elimination of the need to enter a code where a number is being redialed. See *Haimi-Cohen* at Col. 2, Lines 10-19. Therefore, combining the references as suggested by the Examiner would change a principle of operation of *Haimi-Cohen* and/or render *Haimi-Cohen* unsatisfactory for its intended purpose in contradiction to MPEP § 2143.01. Thus, when considered in its entirety, *Haimi-Cohen* teaches away from the claimed invention and is an improper basis for a rejection under 35 U.S.C. § 103 because there is no suggestion or motivation to combine the references.

In addition, as described above, to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. See MPEP § 2141.01(a). Applicants submit that *Haimi-Cohen* is not analogous prior art because *Haimi-Cohen* is not directed to calling card systems. *Haimi-Cohen* describes a wireless communications system adapted to prevent the theft of wireless service. See, e.g., Title. *Haimi-Cohen*

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describes a personal identification number (PIN number) which may be used as a password to protect a wireless communications terminal. See *Abstract*. Thus, *Haimi-Cohen* describes a security code for use with a cell phone. *Id.* *Haimi-Cohen* does not refer to calling cards. Accordingly, *Haimi-Cohen* is not analogous prior art and cannot be relied upon in a rejection under 35 U.S.C. § 103.

Therefore, Applicants submit that claim 11 is patentable over *Cai* in view of *Haimi-Cohen*. Withdrawal of the rejection is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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